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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,130	12/20/2001	Christine J. Landry-Coltrain	82966LMB	2370

7590 07/14/2005

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,130

Applicant(s)

LANDRY-COLTRAIN ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 47 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-46, 48-51, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other:

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1. Claims 21-46, 48-51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (Japanese Kokai Patent Application No. Hei 7[1995]-137432). With respect to the new claim limitations, it is noted that the particles of Maeda et al. are cross-linked [0008]. With respect to the limitation of the percentage of particles with a mean particle size below 0.5 microns, Maeda et al. uses different terminology to recite particle size, but it appears that its ranges would overlap with those instantly claimed. Maeda et al. disclose a volume average particle size D that can be 0.5 microns. In addition, 70 wt % or more of the particles are in the size range of $0.5D$ - $2.0D$ (i.e. 0.25 microns to 1 micron). Applicants claim 21 requires that numerically at least 58% of the particles have a mean diameter of less than 0.5 micrometers. Since this is a numerical percentage that would permit will over 58% of the particles by weight to have particle sizes over 0.5 microns, the claim reads on Maeda et al. (the particle size ranges overlap). Such particle size distributions would clearly have been suggested by [0006] of Maeda et al. In addition, claim 29 states that the particles of claim 21 are "a component of an at least bimodal system" including other (larger) particles. If this is the case then the percentage set forth in claim 21 is essentially non-limiting. Claim 21 does not appear to recite the complete set of component particles which may be present.

The amendment to claim 29 does not overcome the applicability of the Maeda et al. reference. As it is written, the claim is broad enough for multiple "at least bimodal" systems to be present. Such multiple systems could cancel out the modality of the other systems that are present. Assuming that the porous particles of Maeda et al. are

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mono-modal when taken as a whole, when subdivided into such systems, one system would be present which was at least bimodal and would have a mean particle diameter of greater than 0.5 micrometers.

2. Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive. Rejection under 35 USC 112 has been withdrawn in view of applicants' amendments, but the record is unclear as to whether the values in the specification are actually numerical percentages of weight percentages. They have been treated as numerical percentages since there is nothing of record to demonstrate that a weight percentages was intended. Applicants state that Table B indicates at least a 4-fold increase in 60% gloss when more than 58% of the particles have a particle diameter of more than 58%. First, it would have been expected to one of ordinary skill in the art that gloss increases when smaller particles are used. If gloss is an important criteria, then one of ordinary skill in this art would have known to include smaller particles such as those commonly used in the art to form gloss layers. See for example Ogawa et al. (5,576,088), col. 5, lines 13-15. Results of increased gloss would be expected when smaller particles are included in the medium. While Maeda et al. may recognize certain drawbacks to the inclusion of small particles, one of ordinary skill in this art would have found it obvious to weigh all of the pros and cons of this aspect of the invention to determine appropriate sized particles for inclusion in the layer.

Second, some of the values in applicants' table are not understood. With respect to the comparisons, it is unclear how it was determined that the comparisons have no percentage of particles under .5 microns in size from data on mean particle diameter. If

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the average diameter is .682 microns, one would expect some percentage of the particles to have diameters under .5 microns unless the particle size was carefully controlled to exclude all smaller particles. The particles of Maeda et al. may have a weight average particle size of 0.5 microns which numerically would require more than half numerically to be less than 0.5 microns in size. Therefore, it would be expected that the range of particle sizes of Maeda et al. either overlaps with that of applicants or is not patentably distinct therefrom.

Contrary to applicants' arguments with respect to claim 29, the other modes of particles recited therein are not required to be and would not have been expected to be present in a different layer without an explicit recitation of this structure.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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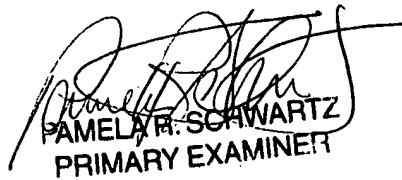
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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz

July 9, 2005


PAMELA R. SCHWARTZ
PRIMARY EXAMINER